

Bereskin & Parr

INTELLECTUAL PROPERTY LAW

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Applicant : COTE et al.
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Title : POTTING METHOD FOR MEMBRANE MODULE
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Examiner : MENON, Krishnan S.
Docket No. : 4320-556
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REPLY BRIEF

This Reply Brief is submitted by the Applicant in response to the Examiner's Answer mailed August 20, 2007.

Status of Claims

The statement of the status of claims contained in the Appeal Brief remains unchanged.

Grounds of Rejection to be Reviewed on Appeal

The statement of the grounds of rejection to be reviewed on appeal contained in the Appeal Brief remains unchanged.

Arguments in Reply to Examiner's Arguments

Re Claim 38:

The Examiner stated in the first two lines of page 9 that Applicant argues that the "resin inlet port (57)...would be removed...". This appears to be a typographical error. For clarity, Applicant has made this argument regarding outlets 57, rather than an inlet port.

The Examiner stated that the entire argument regarding the absence of port 57 is improper, because there is no basis in the reference that it would be absent.

With respect, Applicant submits that the argument concerning outlet 57 is proper because it demonstrates by example that Dannenmaier fails to disclose each limitation of claim 38, and so cannot anticipate claim 38. This argument has been set out in greater detail in the Appeal Brief, for example, at par. (ii) on page 6-7 of the Appeal Brief, noting that relevant details concerning the outlet of a resin injection duct and its position relative to a block of resin (as claimed in claim 38) are not disclosed in Dannenmaier.

The Examiner appears to have admitted this point, stating that "the reference does not say that the location of trimming need be as argued; it may be at a point beyond outlet 57 in Figure 6..." [emphasis added]. Applicant agrees that Dannenmaier is not clear on this point, and that as a result, Dannenmaier fails to put a person skilled in the art in possession of the invention defined by claim 38, and so fails to anticipate claim 38.

Regarding Examiner's argument suggesting the trim line is beyond outlet 57 (middle of page 9 of Examiner's Answer), Applicant submits that this reasoning is mere speculation, unsupported by the reference itself. To the extent that the Examiner is

proffering this argument to show the missing claim elements are inherent in the reference, Applicant submits that the evidence of record is insufficient to support such a finding. In particular, Applicant submits that:

"To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

In re Robertson, 169 F. 3d 747, 745, 49 USPQ2d 1949, 150-51 (Fed. Cir. 1999)
[emphasis added].

The Examiner's arguments fall short of this requirement, and in fact appear to acknowledge the non-necessity of the presence and/or relative position of the outlets 57 in the reference.

Furthermore, Applicant submits that the reasoning supporting the Examiner's interpretation of the position of the trim line is unsupported by the reference, and fails to address certain enablement issues that would be apparent to one skilled in the art. For example, fibers extending beyond the housing would allow resin to leak out of the housing during potting, thus failing to provide a block of potting resin (see also the last paragraph on page 7 of Applicant's Appeal Brief).

Finally, the Examiner argues that even if the Dannenmaier device in Figure 7 had been trimmed as postulated by the Applicant to make the article of Figure 7, the reference would still read on the claim. The Examiner supports this assertion by stating that the injection duct of Dannenmaier is full of resin, and there is no discontinuity of the cured resin between the resin block and the resin in the injection duct.

Applicant submits that this assertion is also unsupported by the evidence of record. Dannenmaier does state that the housing positions 21, 23 can be sealed together by means of the potting compound when potting the hollow fibers (pg. 11, lines 25-30, WO '478). However, it is the resin in the potting channels 55 that sticks together connected housing portions 21, 23 (pg. 12, lines 24-26, WO '478). There is no teaching that resin

in the channels 55 is continuous with resin in the potting cavity other than through the outlets 57 which would, at least in the scenario being considered, be removed when trimmed.

Furthermore, Applicant submits that whether or not the resin in the duct is continuous in some way with resin in the potting recess (which Applicant submits is not the case), the duct and potting recess define separate structural elements. Accordingly, Dannenmaier would still fail to disclose a duct having an outlet plugged by a block of resin in a potting recess having ends of membranes potted therein.

Re: Claim 39

The Examiner stated that all the limitations of claim 39 are also present in the reference. With respect, Applicant submits that the same features absent in the references as argued above regarding claim 38 are recited in claim 39, so that the reference fails to anticipate claim 39 for at least the same reasons.

Furthermore, Applicant maintains the argument presented at the bottom of page 9 of the Appeal Brief, and to which the Examiner did not respond, regarding that in Dannenmaier, the inlet 53 of the potting channel is spaced well away from the permeate collection cavity, rather than on an outer surface opposite the permeate collection cavity, as recited in claim 39. Applicant submits that the reference fails to anticipate claim 39 for this additional reason.

Respectfully submitted,

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